

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Ebner *et al.*

Appl. No. 09/712,142

Filed: November 15, 2000

For: **Connective Tissue Growth Factor-3**



Confirmation No. 4465

Art Unit: 1647

Examiner: David Romeo¹

Atty. Docket: 1488.0630002/EKS/KRM

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**Reply to Restriction Requirement and Request for Withdrawal of
Sequence Election Requirement**

Commissioner for Patents
Washington, D.C. 20231

Sir:

In reply to the Office Action dated **June 28, 2002** (Paper No. 6), requesting an election of one invention to prosecute in the above-referenced patent application, Applicants hereby provisionally elect to prosecute the invention of Group I, represented by claims 1-13² and 18.

This election is made without prejudice to or disclaimer of the other claims or inventions disclosed.

This election is made **with** traverse.



¹It is Applicants' understanding that the present Office Action (Paper No. 6) was actually prepared by Examiner Seharaseyon (*see*, header of "Office Action Summary" of Paper No. 6), although Examiner Romeo's name appears on the cover page.

²Applicants assume that the Examiner's recitation of Claims 1-3 within the Group I invention was in error, and that Claims 1-13 were actually intended.

MPEP § 803 states:

Under the statute an application may properly be required to be restricted to one of two or more claimed inventions only if they are able to support separate patents and they are either independent (MPEP § 806.04 – § 806.04(i)) or distinct (MPEP § 806.05 – § 806.05(i)).

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

Thus, even assuming, *arguendo*, that the groups listed by the Examiner represented distinct or independent inventions, restriction remains improper unless it can be shown that the search and examination of both groups would entail a "serious burden." MPEP § 803. In the present situation, no such showing has been made. Clearly, the Patent Office encourages the search and examination of an entire application on the merits, where such search and examination can be made *without* serious burden, even though two separate, non-overlapping searches may be required.  

In the present case, Applicants respectfully assert that the search of restriction groups I-VI does not impose a serious burden upon the Examiner, as a search concerning the patentability of the invention of one group will clearly uncover art of interest to the other groups. Thus, the claims of Groups I-VI should be examined together.

Further, at page 5 of Paper No. 6, the Examiner states:

[t]he claims of Groups I-II are drawn to multiple sequences (SEQ ID NO:1-2 and fragments). Each of the different sequences are independent and distinct because no common structural or functional properties are shared. Accordingly, these sequences are each subject to restriction under 35 U.S.C. § 121. Regardless of the Group elected, Applicant is additionally required to elect a single sequence, which if determined to be patentable, would also be patentably distinct from the other sequences. This requirement is

made under 1192 O.G. 68 Notice (November 19, 1996), as examination of more than one sequence in one application would result in an undue burden on the PTO.

To be fully responsive, Applicants provisionally elect the nucleotide sequence that encodes a polypeptide comprising amino acids from about -19 to about 231 in SEQ ID NO:2.

Applicants make this election **with** traverse, and respectfully request rejoinder of all sequences in the claims of Groups I for the following reasons.

Applicants submit that a search of any nucleotide sequence of Group I would provide useful information for any other sequence of Group I. Applicants submit that the nucleotide sequences within the Group I claims are sufficiently similar (*e.g.*, encoding full-length, full-length minus the N-terminal methionine, mature, 50 mer polypeptides) so as not to create an undue burden on the Examiner. That is, a search of all of the sequences together would largely, if not entirely, overlap. Because the searches for all sequences of Group I would overlap, the search and examination of both groups would not entail a serious burden.

Further, Applicants point out that the Examiner has not addressed MPEP § 803.04, directed to nucleotide sequences. Pursuant to the notice *Examination of Patent Applications Containing Nucleotide Sequences*, 1192 O.G. 68 (November 19, 1996)(which is briefly mentioned by the Examiner at page 5 of Paper No. 6), § 803.04 holds that even when nucleotide sequences encoding different proteins are contained in an application, a reasonable number, normally ten, sequences will be examined in a single application. As stated above, Applicants submit that the nucleotide sequences within the Group I claims are sufficiently similar so as not to create an undue burden on the Examiner, and are distinguishable from the "different sequences" contemplated by MPEP § 803.04; "[N]ucleotide sequences encoding the same protein are not considered to be independent and distinct inventions and will continue to be examined

together." *Id.* Thus, Applicants respectfully submit that the present requirement for election is improper. However, even if the Examiner contends that the instant sequences constitute different sequences within the scope of § 803.04, Applicants submit that a reasonable number of such sequences should be examined together, and the Examiner has given no indication why the search of ten sequences is unreasonable in the present case.

Thus, Applicants respectfully request that the requirement for an election of a particular sequence be withdrawn and that all of the sequences of the Group I invention be examined together. At the very least, Applicants respectfully request that nucleotide sequences encoding the full-length protein (with and without the N-terminal methionine) as well as the mature protein be rejoined. Such a requirement is unprecedented and telephone discussions with several Supervisory Patent Examiners have acknowledged its impropriety.

Reconsideration and withdrawal of the Restriction Requirement, and consideration and allowance of all pending claims, are respectfully requested.

It is not believed that extensions of time are required, beyond those that may otherwise be provided for in accompanying documents. However, if additional extensions of time are necessary to prevent abandonment of this application, then such extensions of time are hereby

Respectfully submitted,

Karen R. Markowicz

Date: 7/22/02

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